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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/907,687 08/08/97 SABOURIN

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IM22/0425

EXAMINER

ALIX, YALE & RISTAS, LLP
750 MAIN STREET
HARTFORD CT 06103-2721

ALVDM

ART UNIT	PAPER NUMBER
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1731
DATE MAILED:

04/25/00

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

3335
3336
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Office Action Summary

Application No.
08/907,687

Applicant(s)
SABOURIN

Examiner
Steve Alvo

Group Art Unit
1731



☒ Responsive to communication(s) filed on Feb 8, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2, 7, 15-27, and 29-37 is/are pending in the application.

Of the above, claim(s) 15-22 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2, 7, 23-27, and 29-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31, 2, 7, 23, 25-27, 32, 33-35, 29, 30, 36, 37 and 24 are rejected under 35

U.S.C. 103(a) as obvious over PRUSAS et al with or without LUNAN et al or PCT 96/41914.

PRUSAS et al (column 4, lines 42-49) teaches conditioning fiber containing material at an elevated temperature and pressure with steam (column 8, lines 17-30) compressing the chips to a ratio of 3/1 to 5/1 (column 3, lines 14-15 and 36-38 and paragraph bridging columns 3-4) and chemically "refining" the chips (Fig. 5 for Kraft pulping process and column 8, lines 9-12 for refining the chips). It would have been obvious to the artisan that the high temperature steaming of PRUSAS et al would be under pressure. If this is not obvious then such would have been obvious from the teachings of LUNAN et al which teaches using high pressures (225-620 kPa or 32-90 psi) in the presteaming stage for short periods of time (16 seconds) to prevent discoloring of the pulp (see Abstract) prior to a pulp refining process (TMP). Or obvious to use high temperatures and short steaming times (10-30 seconds) as taught by PCT 96/41914. The "destructuring the fibers without significant breakage across grain boundaries" is a direct result of the "conditioning" of the fibers. The same "conditioning" is taught by the applied art. At best Applicant is optimizing the "conditioning" of the prior art. There is a reasonable expectation that the conditioning of the prior art would yield a feed material having the desired amount of

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destructuring. *In re O'Farrel*, 7 USPQ2d 1673, 1680-81. In any event, it is well settled that an artisan with ordinary skill would have found it obvious to determine workable or even optimum values for an art recognized, result effective parameter, such as the proper amount of compression, *In re Boesch*, 205 USPQ 215, 219; *In re Aller*, 105, USPQ 233, 235.

Claims 31, 2, 7, 23, 25-27, 32, 33-35, 29, 36, 37 and 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31 and 36 call for pressures of 10-100 psi and temperatures of 90-120 degrees C. Such do not correspond to the instant disclosure or the steam tables. The specification indicates that a temperature of 90-120 degrees C is used with pressures of 15-25psi. Thus the claimed ranges are confusing. The term "without an intervening chemical digester" has not been disclosed, thus its meaning is confusing. The specification indicates that chemicals can be added to the chips and then sent to a bin. The holding of chips impregnated with chemicals in a vessel would cause delignification (digestion).

Claims 31, 2, 7, 23, 25-27, 32, 33-35, 29, 36, 37 and 24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification indicates that a temperature of 90-120 degrees C is used with pressures of 15-25psi. Thus the claimed ranges were not disclosed in combination. The term "without an

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intervening chemical digester" has not been disclosed. The specification indicates that chemicals can be added to the chips and then sent to a bin. The holding of chips impregnated with chemicals in a vessel would cause delignification (digestion). It is not clear where three steaming stages, e.g. claims 31 and 36 are disclosed or where rpm's of "greater than 1500" or "greater than 1800" are disclosed.

The art rejection of claim 37 will be dropped if the pressures of 15-25 were claimed in the first two stages, the compression ratio of claim 32 was claimed and if the term "a temperature at least 10 degrees C above the glass transition temperature was added to the claim. The claim should be written in independent form containing all the limitations of claim 36. This will not by itself overcome the 35 U.S.C. 112 rejections. Applicant needs to point out where the three pressure steps of claim 36 are disclosed.

When filing an "**Official**" FAX in Art Unit 1731, please indicate in the Header (upper right) "**Official**" for papers that are to be entered into the file. The "**Official**" FAX phone number for this Art Unit is (703) 305-7718 for all papers except amendments after final, for amendments after final the FAX number is 703-305-3599. When filing an "**Unofficial**" FAX in Group 1730, please indicate in the Header (upper right) "**Unofficial**" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The "**Unofficial**" FAX phone number for this Art Unit (1731) is (703) 305-7115.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from 6:00 AM - 2:30 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is (703) 308-0661.

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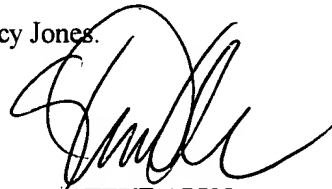
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STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731

MSA
April 24, 2000